

**REMARKS/ARGUMENTS**

Claims 1-18 are pending in the present application. Claims 1-18 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Amendments to claims 1, 9, 11, 13 and 14 have been made to overcome the 35 U.S.C. § 112, second paragraph, rejections. In addition, claims 1-4, 6 and 8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Banck (U.S. Pat. No. 2,265,336). Claims 1-3, 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chen (U.S. Pat. No. 5,826,719). Claims 1-4, 6 and 8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Pangerc et al. (Pub. No. 2004/0256265). Claims 5 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 1 and 6 and in further view of Huot Jr. et al. (U.S. Pat. No. 6,206,189). Claims 9-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pangerc et al. in view of Omata et al. (U.S. Pat. No. 6,247,595). Claims 14-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Banck in view of Mackie (U.S. Pat. No. 1,955,646) and Blasko et al. (U.S. Pat. No. 5,228,590). Applicant respectfully traverses all rejections.

**Rejection of Claims Under 35 U.S.C. § 102**

Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a

single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 1 has been amended to require "a retractable door pivotally connected and positioned on the first end wall of the housing to provide an access to the second compartment." None of the cited references Banck, Chen, or Pangerc teach a retractable door pivotally connected and positioned on an end wall of a housing to provide access to a second compartment. Instead Banck teaches a rectangular slide drawer 12 that has a front plate 13 that permits grasping by the thumb and finger of one hand so that the drawer may be pulled out, as indicated by dotted lines in Fig. 2 (Col. 2, lines 46-55). Thus, drawer 12 slides out of housing 1 and is not pivotally connected within the housing.

The Chen reference also does not teach a retractable door pivotally connected and positioned on the first end wall of a housing. Instead, Chen teaches an insert 20 that may be engaged

in the upper space 101 of the base 12, and a drawer 30 that is slidably engaged in the opening 16. (Col. 2, lines 7-15). Thus, Chen does not teach a retractable door pivotally connected and positioned on the first end wall of the housing to provide access to a second compartment.

Pengerc teaches a door 38 with a projection 40 that fits in the slot 36, and slides within the flange 34. The door 38 is slidably inside the flange to cover a compartment. (Para. 0016). Therefore, the door 38 slides within flange 34 and is not pivotally connected and positioned on the first end wall of a housing to provide access to a second compartment.

Consequently, each and every limitation of amended claim 1 is not met by the three cited references and the anticipation rejections of the references must be withdrawn. Claims 2-8 depend on claim 1 and for at least this reason, these claims are also considered in allowable form.

Rejection of Claims Under 35 U.S.C. § 103

Claims 9-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pengerc et al. in view of Omata. The Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Omata reference is not analogous art and should not be considered in an obviousness analysis. The reference relied upon by the Examiner must either be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

Further, the Omata reference relied upon by the Examiner is not in the Applicant's field of endeavor. When regarding the field of endeavor, the present invention deals particularly with a container for storing and transporting punches and dies. (Pg.

1, lines 16-17). In contrast, the Omata reference is directed toward a conventional case for carrying and dispensing refreshing tablets. (Col. 1, lines 12-13). The Omata reference is not directed toward nor does it discuss a container for punches and dies. Consequently, the reference relied upon by the Examiner is not in the field of the inventors' endeavor and should not be relied upon.

Further, the Omata reference is not reasonably pertinent to the Applicant's problem. The Federal Circuit has clarified how to determine whether a reference is reasonably pertinent to the particular problem in which the endeavor was involved as follows:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992). (Emphasis added); See also, MPEP § 2141.01(a). According to the Applicant's specification, the purpose of the present invention is to provide "a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment." (Pg. 1, lines 7-9). The purpose of the Omata reference is to "provide an inexpensive, flat tablet case comprising a relatively small number of parts and satisfactory in usability." (Col. 22-26).

The Applicant's reference has a different purpose as compared to that of the Omata reference. Specifically, Applicant's reference is for providing a container that not only

securely holds punches and dies but also one that ensures cleanliness of the equipment, whereas the Omata reference is for providing an inexpensive, flat tablet case comprising a small number of parts. Therefore, Omata solves a different problem than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the reference cited by the Examiner. Because the reference relied upon by the Examiner is not in the field of the inventor's endeavor and is not reasonably pertinent to the specific problem with which the inventor was involved, the Omata reference is not analogous and should not be considered in an obviousness analysis.

Even if Omata is considered analogous art, there is not a motivation or suggestion to combine Omata with Pangerc to arrive at the claimed invention. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the

very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g., Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g.,

McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All obviousness rejections asserted by the Examiner are based on a combination of prior art references, e.g., the screwdriver bit package of Pangerc combined with the housing insert of Omata having detachable halves that form a substantially hollow interior. To justify this combination the Examiner states "to provide the housing of Pangerc et al. in the manner of Omata et al. would have been obvious, as housings formed in such a manner are common and the provision fails to distinguish any new and unexpected result." (Office action, page 5). Rather than pointing to specific information in Omata that suggests the combination with the package of Pangerc, the Examiner describes a general function of an insert. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art reference such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis. See, e.g., Promold & Tool, 75 F3d. 1568, 1573, 37 USPQ2d. 1626, 1630 (Fed. Cir. 1996).

To the contrary, the Examiner's decision is based on a discussion of the ways that the multiple prior art references are combined to read on the claimed invention. (Office action, page 5). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Omata reference teaches or suggests its combination with Pangerc to yield the claimed invention.

Finally, even if Omata is analogous art and there is a motivation or suggestion to combine the two references, the Examiner still has not shown a *prima facie* case of obviousness because the combined device will not have each and every limitation of claims 9-13. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Specifically, the combination would not provide a means for releasably securing the insert within the container. The Pangerc reference does not teach a means for releasably securing the insert within the container. Specifically, Pangerc teaches that during the assembly of the unit, apertures 30, 32 as well as 52, 54 of the housing members 12, 14 are positioned onto the flanges 70, 72 which form the pivot of the bit retainer 18 (Para. 0021). Thus, Pangerc teaches securing the bit retainer 18 to the housings 12, 14 to allow pivoting but does not teach a means for releasing the bit retainer 18 once positioned onto flanges 70, 72. Omata is a flat tablet case having a flat top half 10 and bottom half case 30 with a hinged cap 50 having a hinged portion 51. (Col. 2, lines 44-52). Omata does not teach an insert in a housing nor does it teach a means for releasably securing an insert within a container. Because neither Pangerc nor Omata teaches a means for releasably securing an insert within a container, even if these references were combined as



suggested by the Examiner, the claimed invention would not result. Therefore, the obviousness rejection of claim 9, as a matter of law, cannot stand. Claims 10-13 depend on claim 9 and for at least this reason are also considered allowable subject matter.

Claims 14-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Banck in view of Mackie and Blasko. Again, Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Mackie and Banck references are not analogous art and should not be considered in an obviousness analysis. Specifically, neither of these references relied upon by the Examiner are in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 230 USPQ 313, 315. The Banck and Mackie references relied upon by the Examiner are not in the Applicant's field of endeavor. When regarding the field of endeavor the present invention deals particularly with a container for storing and transporting punches and dies. (Pg. 1, lines 16-17). In contrast, the Banck reference is directed toward an improved cigarette and match dispenser. (Col. 1, lines 1-2). The Mackie reference is directed toward a cigarette package with an improved structure. (Col. 1, lines 1-3). Thus, Banck and Mackie references are not directed toward nor do they discuss a container for storing and transporting punches and dies. Consequently, these references relied upon by the Examiner are not in the field of the inventor's endeavor and should not be relied upon.

The Banck and Mackie references likewise are not reasonably pertinent to Applicant's problem. According to Applicant's specification, the purpose of the present invention is to

provide "a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment". According to Banck, the device is "for the purpose of dispensing cigarettes and matches." (Col. 1, lines 4-5). The purpose of Mackie is to provide "means to permit vision of a portion of the cigarettes within the package adjacent to the cigarette discharge mechanism." Col. 1, lines 6-12).

The Applicant's reference has a different purpose as compared to the Banck and Mackie references. Specifically, the Applicant's reference is for a container that can securely hold the punches and dies while at the same time ensure the cleanliness of the equipment, whereas the Banck reference is for providing a device that dispenses cigarettes and matches, and the Mackie reference is for a means to permit vision of a portion of the cigarettes with the package adjacent to the cigarette discharge mechanism. Therefore, Banck and Mackie solve different problems than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the references cited by the Examiner. Because the references relied upon by the Examiner are not in the field of the inventor's endeavor and are not reasonably pertinent to the specific problem with which the inventor is involved, the Banck and Mackie references are not analogous and should not be considered in an obviousness analysis.

Even if Banck and Mackie are considered analogous art, the Examiner has not provided a motivation to combine the Mackie reference with Banck. To justify the combination of Mackie and Banck the Examiner states "to substitute the door of Mackie for either of the doors of Banck would have been obvious to facilitate access to the interior of the housing in a manner suggested by Mackie." (Office action page 5). Upon review of

Mackie, it does not suggest or teach a device that facilitates access to the interior of a housing. Instead, Mackie teaches a door having a front wall 8 and a means of resiliently urging the door always into the closed position. (Col. 2, lines 88-92). Thus, Mackie teaches preventing one access to the interior of the housing. In this respect, Mackie teaches away from the proposed combination. This is a point the Examiner did not address in the office action.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Here, because Mackie teaches resiliently urging the door always in the closed position, one skilled in the art, upon reading Mackie, would have been led on a path divergent from that taken by the Applicant.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Mackie that teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand. Thus, claim 14 is considered in allowable form and because claims 15-18 depend on claim 14, for at least this reason, are additionally considered in allowable form.

CONCLUSION

In view of the above remarks, Applicant believes that claims 1-18 are in condition for allowance and Applicant respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

- JLH/bjs -